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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,292	03/30/2004	Mark DiSilvestro		4534

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MAGINOT, MOORE & BECK, LLP
CHASE TOWER
111 MONUMENT CIRCLE
SUITE 3250
INDIANAPOLIS, IN 46204

EXAMINER

LA, ANH V

ART UNIT PAPER NUMBER

2612

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,292

Applicant(s)

DISILVESTRO ET AL.

Examiner

Anh V. La

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-13 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 4-7 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/17/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 8-10, 12-13, and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrender in view of Ishikawa (US 6,447,448).

Regarding claim 1, Carrender discloses a medical implant component 12 comprising a component body 12, and an RFID tag 30 storing information related to the component, the RFID tag associated with the component body so that the stored information can be accessed by an independent reader 30 (paragraphs 21, 30, 32, 31, 33). Carrender does not disclose the medical implant component being an orthopaedic component. Ishikawa teaches the use of a medical implant component being an orthopaedic component (figures 8, 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the medical implant component being an orthopedic component to the component of Carrender as taught by Ishikawa for the purpose of effectively monitoring the orthopaedic component.

Regarding claim 2, Carrender as modified by Ishikawa discloses the RFID tag being embedded within the component body (fig. 3A, p.8).

Regarding claim 3, Carrender as modified by Ishikawa discloses all the claimed subject matters as set forth above in the rejection of claim 2, but does not disclose the RFID tag being molded within a molded body of the component body (claim 3). Ishikawa

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teaches an the RFID tag being molded within a molded body of the component body (fig. 8). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the RFID tag being molded within a molded body of the component body to the component of Carrender as taught by Ishikawa for the purpose of effectively monitoring the orthopaedic component.

Regarding claim 8, Carrender discloses a transmission receiver, an information storage element, and a control circuit (p. 21, 30,31-33).

Regarding claim 9, Carrender discloses a passive power supply (p. 26).

Regarding claim 10, Carrender discloses the storage element having read/write capabilities (p. 33).

Regarding claims 12-13, Carrender as modified by Ishikawa discloses all the claimed subject matters as set forth above in the rejection of claim 1, but does not disclose a housing having a cavity and an engagement feature (claim 12), a recess (claim 13). Ishikawa teaches a housing having a cavity and an engagement feature, a recess (fig. 8). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a housing having a cavity and an engagement feature, a recess to the component of Carrender as taught by Ishikawa for the purpose of effectively monitoring the orthopaedic component.

Regarding claim 17, Carrender discloses a method for associating information related to a medical implant component with the component comprising the steps of storing information related to the component in an information storage device 36, engaging the storage device to the component, and remotely accessing the information

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stored in the information storage device (p. 21, 30-32). Carrender does not disclose the medical implant component being an orthopaedic component. Ishikawa teaches the use of a medical implant component being an orthopaedic component (figures 8, 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include the medical implant component being an orthopaedic component to the component of Carrender as taught by Ishikawa for the purpose of effectively monitoring the orthopaedic component.

Regarding claim 18, Carrender discloses remotely accessing occurring before the orthopaedic component is implanted in a patient (p. 21, 30-32).

Regarding claim 19, Carrender discloses remotely accessing occurring after the orthopaedic component is implanted in a patient (p. 21, 30-32).

Regarding claim 20, Carrender discloses product identification, part number, manufacturer, manufacture date and inspection information (p. 30).

Regarding claim 21, Carrender discloses the stored information being stored in the storage device by the caregiver implanting the orthopaedic component (p. 30).

Regarding claim 22, Carrender discloses patient identification, medical history, date of implant surgery, care giver information (p. 32).

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrender in view of Ishikawa as applied to claim 10 above, and further in view of Holtzman.

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Regarding claim 11, Carrender as modified by Ishikawa discloses all the claimed subject matters as set forth above in the rejection of claim 10, Ishikawa further discloses the orthopaedic component replacing at least a portion of a bone in a joint (fig. 8), but does not disclose an EEPROM. Holtzman discloses the use of an EEPROM (col. 3, lines 25-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to include EEPROM to the component of Carrender modified by Ishikawa as taught by Holtzman for the purpose of effectively storing information.

4. Claims 4-7, 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Answers to Remarks

5. Applicant's arguments filed on April 17, 2006 have been fully considered.

Applicant's arguments with respect to claims 1 and 17 have been considered but are moot in view of the new ground(s) of rejection.

6. **THIS ACTION IS MADE NON-FINAL.**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh V. La whose telephone number is (571) 272-2970. The examiner can normally be reached on Mon-Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ANH V. LA
PRIMARY EXAMINER

Anh V La
Primary Examiner
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AI
June 26, 2006